

REMARKS

This responds to the Office Action dated September 18, 2008.

Claims 1 and 6-16 are amended, no claims are canceled, and no claims are added; as a result, claims 1-16 remain pending in this application. The amendments are fully supported by the original claims of the application and do not add new matter.

§103 Rejection of the Claims

Claims 1, 2, 4, 5 and 6 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Slezak (U.S. Patent No. 6,006,257) in view of Morrison (U.S. Patent No. 5,815,671), Emura et al. (U.S. Patent Application Publication No. 2002/0129371 A1, hereinafter "Emura") and Bacon et al. (U.S. Patent No. 6,212,278 B1, hereinafter "Bacon").

For at least the reasons set forth below, Applicants respectfully submit that this rejection is improper, and the identified claims are non-obvious over Slezak in view of Morrison, Emura and Bacon, and are therefore allowable. Rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.¹

Although Applicants believe that the original pending claims are allowable over the art of record, Applicants have amended independent claim 1 to incorporate some features of the dependent claim 8 to expedite allowance of this application. As a result, amended independent claim 1 now recites, in pertinent part, as follows:

providing indicators for a first advertisement and a second advertisement .
.. a first priority level indicator and a first category indicator associated with the first advertisement, and a second priority level indicator and a second category indicator associated with the second advertisement; and

broadcasting a video signal comprising program content, said plurality of advertisements, and said indicators to the plurality of set top boxes, wherein the set top box computer program code is to compare the first category indicator and the second category indicator to a stored category value; compare the first priority level indicator and the second priority level indicator; and select said second advertisement when the second category indicator corresponds to said stored

¹ *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006)

category value and the second priority level indicator is greater than or equal to said first priority level indicator.

(Emphasis added throughout)

The Final Office Action, at pages 11 and 12, in rejecting claim 8, when discussing this claim limitation concedes that Slezak does not disclose this limitation and relies upon Morrison in Table 1, FIG. 2 item 12, col. 3, lines 16-55, and col.5, lines 1-14 to show a first advertisement, a first advertisement indicator, a second advertisement, and a second advertisement indicator. Morrison in Table 1, FIG. 2 and the cited passages, at most describes “a program break flag that precedes a break in the program for insertion of message material . . . and a message code flag contains message code data related to message material.”² However, the cited portions of Morrison do not disclose the claimed features of “*a first priority level indicator and a first category indicator associated with the first advertisement, and a second priority level indicator and a second category indicator associated with the second advertisement,*” as recited in the amended claim 1.

Furthermore, Morrison in FIG. 5, col. 3, lines 16-55 and cols. 5-6, lines 67-5, cited by the Final Office Action, does not disclose the amended claim 1 features of “*the set top box computer program code is to compare the first category indicator and the second category indicator to a stored category value; compare the first priority level indicator and the second priority level indicator; and select said second advertisement when the second category indicator corresponds to said stored category value and the second priority level indicator is greater than or equal to said first priority level indicator.*”

In Stark contrast to claim 1, Morrison merely checks a message category (MESCT) in MC with MESCT in PBF (Program Break Flag) to allow the message to be presented (FIGs. 5 and 6), or “compares this message code data with the previously mentioned program break flag stored in the receiver.”³ Nonetheless, the cited portions of Morrison are silent with respect to the limitation of “*select said second advertisement when the second category indicator corresponds to said stored category value and the second priority level indicator is greater than or equal to said first priority level indicator,*” as recited in the amended claim 1.

² Morrison, col. 3, lines 39- 48

³ Morrison, col. 3, lines 48-50

As such, Morrison does not disclose the limitations of “*broadcasting a video signal comprising program content, said plurality of advertisements, and said indicators to the plurality of set top boxes, wherein the set top box computer program code is to compare the first category indicator and the second category indicator to a stored category value; compare the first priority level indicator and the second priority level indicator; and select said second advertisement when the second category indicator corresponds to said stored category value and the second priority level indicator is greater than or equal to said first priority level indicator,*” as recited in the amended claim 1.

The Final Office Action, at page 4 relies on Emura to teach assigning priority levels to advertisement content in the form of importance indicators. Emura, however, does not teach or suggest the above feature to *compare the first priority level indicator and the second priority level indicator*, which was shown to be missing from Morrison. Accordingly, at least for the reasons set forth above, Slezak, Morrison and Emura, individually or in the combination, fail to teach or suggest each and every element of the amended claim 1.

Therefore, Applicants respectfully submit that there are substantial differences between what is claimed and what the Final Office Action contends to be shown in Slezak, Morrison and Emura, whether they are considered separately or in combination. Because the cited documents do not show all of the elements of the claimed subject matter of the amended claim 1, those differences are significant and non-obvious to a person of ordinary skill in the art at the time the application was filed. Furthermore, nothing in the disclosures of Slezak, Morrison or Emura provides a reason for a person of ordinary skill in the art to seek to combine Slezak, Morrison and/or Emura in the manner suggested by the Examiner. Accordingly, claim 1 and its dependent claims 2 and 4-5 are not rendered obvious by the proposed combination in the Final Office Action and thus are allowable.

Similar arguments as presented with respect to claim 1 are also applicable to a consideration of the amended claim 6. Thus, claim 6 is not rendered obvious by the suggested combination of references and is also allowable.

Claim 3 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Slezak (U.S. Patent No. 6,006,257) in view of Morrison (U.S. Patent No. 5,815,671), Emura et al. (U.S. Patent

Application Publication No. 2002/0129371 A1), Bacon et al. (U.S. Patent No. 6,212,278 B1) and Eldering et al. (U.S. Patent Application Publication No. 2002/0083443, hereinafter "Eldering").

Claim 3 is dependent on claim 1 and, thus, is deemed to include every limitation of claim 1. As such, at least for the same reasons articulated above with respect to claim 1, claim 3 is not rendered obvious by the combination of Slezak, Morrison, Emura, and Bacon. Eldering is directed at providing a system and method for distributing advertisements (ads) in a television network, e.g., a cable-based network or a satellite network.⁴ However, Eldering fails to teach or suggest the features that were shown to be missing from the combination of Slezak, Morrison, Emura, and Bacon. As such, at least for the reasons noted above, claim 3 is not rendered obvious by the combination of Slezak, Morrison, Emura, Bacon, and Eldering and, thus, is allowable.

Claims 7 and 14 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Slezak (U.S. Patent No. 6,006,257) in view of Emura et al. (U.S. Patent Application Publication No. 2002/0129371 A1) and Dudkiewicz et al. (U.S. Patent No. 6,973,665 B2, hereinafter "Dudkiewicz").

Similar arguments as presented with respect to claim 1 are also applicable to a consideration of claims 7 and 14. Thus, at least for the same reasons articulated above with respect to claim 6, claims 7 and 14 are not rendered obvious by the combination of Slezak and Morrison. Dudkiewicz is directed to "devices and processes for generating metadata for individual program segments, thus allowing program segments to be treated as individual programming events that can be individually evaluated by the user or by user equipment."⁵ However, Dudkiewicz fails to teach or suggest the features that were shown to be missing from the combination of Slezak, Morrison and Emura. As such, at least for the reasons set forth above, claim 3 is not rendered obvious by the combination of Slezak, Morrison, Emura, and Dudkiewicz and, thus, is allowable.

Claims 8, 9, 12, 13 and 15 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Slezak (U.S. Patent No. 6,006,257) in view of Morrison (U.S. Patent No. 5,815,671) and Emura et al. (U.S. Patent Application Publication No. 2002/0129371 A1).

⁴ Eldering, Summary

⁵ Dudkiewicz, Summary

Similar arguments as presented with respect to claim 1 are also applicable to a consideration of independent claims 8 and 15. Thus, at least for the reasons set forth above with respect to claim 1, independent claims 8 and 15 and dependent claims 9, 12 and 13 are not rendered obvious by the combination of Slezak and Morrison and Emura, thus, are allowable.

Claims 10, 11 and 16 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Slezak (U.S. Patent No. 6,006,257) in view of Morrison (U.S. Patent No. 5,815,671), Emura et al. (U.S. Patent Application Publication No. 2002/0129371 A1) and Wachob (U.S. Patent No. 5,155,591).

Claims 10 and 11 and 16 are dependent on claims 8 and 1, thus, are deemed to include the same limitations as these claims. Therefore, at least for the same reasons articulated above with respect to claims 8 and 1, claims 10, 11, and 16 are not rendered obvious by the combination of Slezak, Morrison and Emura. Wachob is directed at broadcasting different commercial messages to different demographically targeted audiences in a cable television system or the like.⁶ However, Wachob fails to teach or suggest the features that were shown to be missing from the combination of Slezak, Morrison and Emura. As such, Slezak, Morrison, Emura, and Wachob, individually or in the combination, fail to teach or suggest each and every element of claims 10, 11 and 16. Thus, these claims are not rendered obvious by the combination and are allowable.

Applicants respectfully request that, in view of the arguments presented above, claim rejections under 35 U.S.C. § 103 (a) be reconsidered, in light of the amendments, and withdrawn.

⁶ Wachob, Abstract

CONCLUSION

Applicants respectfully submit that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicants' representative at (408) 278-4053 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

SCHWEGMAN, LUNDBERG & WOESSNER, P.A.
P.O. Box 2938
Minneapolis, MN 55402
(408) 278-4053

Date December 11, 2008

By

Ali Miresghhi

Ali Miresghhi

Reg. No. 58,726

CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being filed using the USPTO's electronic filing system EFS-Web, and is addressed to: Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on December 11, 2008.

Name John D. Gustav-Wrathall
Paralegal
Schwegman, Lundberg & Woessner

Signature

John D. Gustav-Wrathall